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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,508	09/15/2003	Brandt Gerard Cordelli	JCORD-0001	7398
23599 7590 02/03/2011 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201				
EXAMINER EVANS, KIMBERLY L				
ART UNIT 3629		PAPER NUMBER		
NOTIFICATION DATE 02/03/2011		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mwzb.com

Office Action Summary

Application No.

10/661,508

Applicant(s)

CORDELLI, BRANDT GERARD

Examiner

KIMBERLY EVANS

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2010.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5-8, 11-20, 33, 34 and 39-44 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1, 2, 5-8, 11-20, 33, 34, and 39-44 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This office action in response to the request for continued examination received September 20, 2010.
2. Claims 1, 2, 43, and 44, have been amended. Claims 3, 4, 9, 10, 21-32, and 35-38 were previously cancelled.
3. Claims 1, 2, 5-8, 11-20, 33, 34, and 39-44 are currently pending and have been examined.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 25, 2009 has been entered.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 - (a) Determining the scope and contents of the prior art.
 - (b) Ascertaining the differences between the prior art and the claims at issue.
 - (c) Resolving the level of ordinary skill in the pertinent art.
 - (d) Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 1, 2, 5, 6, 11, 12, 17, 18, 33, 34, 39, 43, and 44 are rejected under 35 USC 103(a) as being unpatentable over Heckman et al., US Patent No 5,875,431 in view of Campbell, US Patent Application Publication No US 2001/0041993 A1.

8. With respect to Claims 1 and 2,
Heckman discloses the following limitations,

- *a computer particularly configured with:*
 - *particular data pertaining to a multiplicity of categories of circumstances relevant to the determination regarding referral of the claim for defense; which either apply or do not apply, and* (see at least Abstract: "...A key aspect of the system and method of this invention is a series of computer programs which provide a strategic planning template outlining the objectives and tasks, and their associated timing. The template is case category and case type specific and presents the "best practices" strategic process from which to launch a legal action..."; column 13, lines 19-24: "...the discrete, objective tasks, tied to process management of tasks, of those cases having achieved the desired outcome or long term goals become the paradigms from which future cases will identify as benchmarks or templates as to what constitutes quality legal services...")
 - *computer-executable instructions for display of the results of applicable categories*
 - *computer-executable instructions particular for determining from the number of categories found to apply* (see at least column 17, lines 23-34: "...The DefenseNet program presents strategies directly relevant to the type of claim or claim conditions currently under consideration by the user.

The DefenseNet computer program presents these strategies as baseline templates. These strategies are comprised of predetermined objectives and tasks to be executed in a predetermined order and pursuant to a predetermined schedule; essentially defining a process--a strategic planning process....")

- *wherein the computer-executable instructions include programmed weightings of the applicable categories used for making the determination and (see at least column 18, lines 27-33: "...The best-practices approach may be based on a single case, an average of, or consensus, of cases, or selected from cases using a weighted average. The weight may be biased towards the results or outcomes of most recent cases, towards cases tried in the jurisdiction of interest, or by any other attribute deemed significant to the final case outcome. ...")*
- *and a programmed threshold of the sum of weightings of the total categories or a sub-set of categories which determines the referral result,(see at least column 10, line 65 through column 11 line 17: "...As a threshold to determining the legal and factual issues, the legal team must determine the case category, case type and scope of legal protection demanded. As explained supra the case category is the general area of law involved in the case; case type refers to the type of legal action sought; and legal notification quantizes the scope of legal protection demanded by categorizing the notification into one of three types: (1)*

Internal notification whereby an injury or harm is reported within the organization, no outside agency or claim has been submitted, and the injury or harm is such that it might lead to a possible lawsuit; (2) External Notification whereby the client is informed by an external agency of a reported injury or harm, and the injury or harm is such that it might lead to a lawsuit; and (3) Legal notice whereby the client is informed that he has been joined in a lawsuit. Based on this analysis, a desired outcome, or long term goal, and legal theories consonant with the facts of the case are set forth..."")

Heckman does not distinctly disclose the following limitations, but Campbell however as shown discloses,

- *whether the claim for defense should be referred to a higher review level* (see at least paragraph 38: "...If the insurance carrier does not agree to use the system 100, the claimant is notified that a settlement will not be reached and the attorney request module 226 offers the claimant the option of referring the insurance claim to an attorney (step 510)...")
- *and the result of the determination of whether a claim for a defense under a liability insurance policy should be referred to a higher review level* (see at least Abstract: "...The claimant is provided with information on the credibility of the insurance claim and easy to use tools to help determine the value of the insurance claim. Additionally, the claimant is provided with

an option to "auction" the insurance claim to an attorney in the event negotiations between the claimant and the insurance carrier do not lead to a settlement...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the legal strategic analysis planning and evaluation control system of Heckman with the automated claim processing and attorney referral system of Campbell because knowledge of the claims credibility and value allows the claimant to negotiate directly and more effectively with the insurance carrier(s). Additionally, the claimant is provided with an option to "auction" the insurance claim to an attorney for legal assistance in the event negotiations between the claimant and the insurance carrier do not lead to a settlement.

9. With respect to Claims 5 and 6,

Heckman and Campbell disclose all of the above limitations, Heckman further discloses,

- *computer-executable instructions for determining, from the number of categories found to apply whether the claim should be automatically referred to a higher review level without further analysis or referred to a higher review level with qualification of an additional analysis.* (see at least column 13, lines 32-42: "...The system and process of this invention (hereafter the "DefenseNet" or System or Process) effectuates the legal business plan

described supra and takes it two steps further by providing an interactive system which is responsive to unforeseen changes affecting the system, and by providing an iteratively converging, dynamically adaptive system whereby uncertainties associated with a "best practices" model or a stochastic strategic model are minimized with continued use.....")

10. With respect to Claims 43 and 44,

Heckman and Campbell disclose all of the above limitations, Heckman further discloses,

- *a determination of whether: the claim either in full or in part is plainly not covered by the policy, the claim either in full or in part is potentially covered and therefore obligates the insurer to defend but not indemnify the policyholder, or the claim either in full or in part is plainly covered by the policy and thus obligates the insurer to both defend the policyholder and pay any settlement or judgment, and (see at least Figures 3-7, column 6, lines 59- 63: "...This section contains a one- or two-page "snapshot" summary of the salient facts of the case that are sufficient to support exposure or liability, an analysis of damages, and the formation of a forecast. It concludes with a list of material issues and summaries of their merit together with a brief description of damages. This section should also include unusual features of the case, such as alleged record alterations potential for publicity or notoriety, or other factors that may materially distort verdict potential or case value. The*

conclusion of this section should set forth the long-term goal, the type of case or area of relevant law, and specific legal theories upon which recovery might be sought. In a transactional legal action, the likelihood of the desired transactional outcome and means for attaining that outcome might be the conclusion of this section...").

- *optionally, also includes a determination of whether the above determinations can be made by the claims handling personnel with or without management review.*(see at least Figure 5, column 24, lines 55-60: "...Following the preliminary analysis step 30 and decision to proceed with the case, the long term goals and case type are defined 34. These steps are described supra with reference to FIG. 3. A law firm is selected 56 by the client to represent them in this case. Specific information on the selected law firm 36, if not already entered into the CostCore program 1, is inputted 57 to the CostCore program 1...")

11. With respect to Claims 33 and 34,

Heckman and Campbell disclose all of the above limitations, Heckman further discloses,

- *wherein the computer includes at least one data entry for information identifying the claim.*(see at least column 16, lines 17-22: "...The system of this invention receives three kinds of data: initial data directed to the administrative and demographic particulars of each law firm subscribed to the system, case specific data relating to the present case, and case outcome

feedback data from which future litigation/legal templates might be drawn.....")

12. With respect to Claim 39,
Heckman and Campbell disclose all of the above limitations, Heckman further discloses,
 - *which further includes computer-executable instructions for changing the programmed weightings applicable to each category based on the previous data indicating that particular categories deserve more or less weight in making the determination.* (see at least column 18, lines 28-33: "...The best-practices approach may be based on a single case, an average of, or consensus, of cases, or selected from cases using a weighted average. The weight may be biased towards the results or outcomes of most recent cases, towards cases tried in the jurisdiction of interest, or by any other attribute deemed significant to the final case outcome ...").
13. Claims 7, 8, and 11-20 are rejected under 35 USC 103(a) as being unpatentable over Heckman et al., in view of Campbell, in further view of Lee et al., US Patent Application Publication No US 2003/0074354
14. With respect to Claims 7, 8, 17-20,

Heckman and Campbell disclose all of the above limitations, the combination of Heckman and Campbell does not distinctly disclose the following limitations, but Lee however as shown discloses,

- *computer is further configured to display the results of applicable categories so that multiple categories are displayed in a primarily prominent portion of the display and other categories are displayed in a secondarily prominent portion, the determination of referral being made from the categories in both such portions*
- *wherein at least one category also contains associated with it one or more selectable data entries which relate to bases for finding the category applicable..(see at least Figures 3, 6, 9, and 14-16, paragraph 36: "...Server system 12 includes a collection component 64 for collecting information from users into centralized database 20, a tracking component 66 for tracking information, a displaying component 68 to display information, a receiving component 70 to receive a specific query from client system 14, and an accessing component 72 to access centralized database 20. Server system 12 further includes a processing component 76 for searching and processing received queries against data storage device 34 containing a variety of information collected by collection component 64... Retrieving component 80 retrieves, downloads and sends information to client system 14 based on a query received from client system 14 regarding various alternatives..."; paragraph 66: "...the user may conduct various types of searches after*

selecting a type of search 724, selecting a library 726, select a section within the library 730, select a sub-section within the section 732, entering a key word or set of key words within a box provided 734 and selecting a go button 738 to conduct the search. Sub-groups exist only by practice areas for streamlining search criteria. The results of the search are displayed on the user interface with hypertext links to direct the user to the specific request ...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the legal strategic analysis planning and evaluation control system of Heckman and the automated claim processing and attorney referral system of Campbell with the Web-based system and method for managing legal information of Lee because the user interface and the Legal Management System (LMS) is an efficient interactive searchable database tool for displaying and providing authorized users access to legal productivity and collaboration tools (Outside Counsel Management System) and provides flexibility to users as well as executives. The system provides the ability for attorneys, managers, employees and database administrators to update, review and generate reports of current information (paragraph 69).

15. With respect to Claims 11 and 12, Heckman, Campbell and Lee disclose all of the above limitations, Lee further discloses,

- *wherein the primarily prominent portion contains five categories.*(see at least Figure 6, paragraph 55: "...Once the user logs onto the system, the main page displays several different logical groups. The information is logically organized under these groups, also referred to as the highest level folders. Each group provides an access to the user to different sub-groups or sections organized under the highest level folder through a hypertext link...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the legal strategic analysis planning and evaluation control system of Heckman with the automated claim processing and attorney referral system of Campbell with the Web-based system and method for managing legal information of Lee because the homepage and user interface is an efficient means to guide the user through the various different parts of the database.

16. With respect to Claims 13 -16,

Heckman, Campbell and Lee disclose all of the above limitations, Lee further discloses,

- *wherein the five categories in the primarily prominent portion are: 1) Preliminary Analysis Suggests Denial; 2) Mixed Suit - Covered and/or Potentially Covered with Uncovered Claims; 3) Key Policyholder Counsel Tenders Claim for Defense or Independent/Claims Counsel Involved; 4) Misrepresentation or Omission in Application and/or Pre-existing Loss Suspected; and one of the following: 5) Umbrella/Excess Coverage by*

Company, 6) Defense Tendered by Other than Named Insured, 7) Latent and/or Continuous and Progressive Injury or Damage, 8) Other Carriers Involved, or 9) Target Claims/Damages Alleged

- *wherein the secondarily prominent portion contains the other categories 5) to 9) not on the primarily prominent portion plus the following categories: 10) Internet-Related Liability Issues, 11) Potential Personal Injury or Advertising Injury, 12) Insolvent Insurer and/or Guaranty Fund Involved or On Notice, 13) SIR of \$100,000 or More, and 14) Employment-Related Claims.*

(see at least Figures 3, 6, 9, and 14-16, paragraph 5: "...The LMS stores business/legal department related data in the database in several separate sections such as a Practice Group Information Section, a Preferred Provider Information Section, a Regional Information Section, a Commercial Transaction Information Section, an Organizational Information Section, an Administrative/Security Information Section, and a Resources Information Section....";

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the legal strategic analysis planning and evaluation control system of Heckman and the automated claim processing and attorney referral system of Campbell with the Web-based system and method for managing legal information of Lee because the user interface and the Legal Management System (LMS) is an efficient interactive searchable database tool for displaying and providing authorized users access to legal productivity and collaboration

tools (Outside Counsel Management System) and provides flexibility to users as well as executives. The system is a gateway to all relevant database applications for the legal community on a real time basis (paragraph 39). Furthermore, Claims 13-16 refer to non-functional descriptive material, "categories" and thus is not given patentable weight because applicant fails to disclose the steps involved in using the features above. Claims 13-16 recite a mere arrangement of data (categories) on the computer display. Moreover, one skilled in the art would recognize that there are multiple possible combinations of organizing the data, displaying the data on the screen as well as printing the data in various reporting formats which still express the same essential matter and process steps (Lee, paragraph 51).

17. Claims 40-42 are rejected under 35 USC 103(a) as being unpatentable over Heckman et al., in view of Campbell, in further view of Lee et al., in further view of Henrion et al., US Patent 7,080,071 B2.
18. With respect to Claims 40 -42,
Heckman and Campbell disclose all of the above limitations, Heckman further discloses,
 - *which further includes computer-executable instructions for changing the programmed weightings applicable to each category based on the previous data indicating that particular categories deserve more or less weight in*

making the determination. (see at least column 18, lines 28-33: "...The best-practices approach may be based on a single case, an average of, or consensus, of cases, or selected from cases using a weighted average. The weight may be biased towards the results or outcomes of most recent cases, towards cases tried in the jurisdiction of interest, or by any other attribute deemed significant to the final case outcome ...").

Heckman and Campbell disclose all of the above limitations, Heckman, and Campbell do not distinctly disclose the following limitations but Henrion however as shown discloses

- *wherein the programmed weightings for the categories in the primarily prominent portion are higher than the programmed weightings for the categories in the secondarily prominent portion* (see at least Abstract: "...The system dynamically selects those questions to ask that are most likely to help discriminate between items based on information about user preferences and differences between the items, based on information about the user obtained so far. The system scores the available items in terms of how well they match user's needs and preferences and generates lists of recommended items..."; column 3, lines 20-29: "...Weight" generally refers to a numerical weighting for each attribute that estimates the relative importance of that attribute for a user in making a

selection. The weight may be based on prior expert judgment of the importance of each attribute for a class of users or on an input from or other information about the user. A high weight is generally assumed for an attribute for which an absolute requirement has been specified, wherein "requirement" refers to a required value or set of values for an attribute to meet the needs or preferences of a user..."

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the legal strategic analysis planning and evaluation control system of Heckman and the automated claim processing and attorney referral system of Campbell with the Web-based system and method for managing legal information of Lee and the automated decision advisor of Henrion because it is an efficient tool for assisting users in making an informed and confident choice among the items.

Conclusion

19. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kimberly L. Evans** whose telephone number is **571.270.3929**. The Examiner can normally be reached on Monday-Friday,

9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Jami Plucinski** can be reached at **571.272.6811**.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free). Any response to this action should be mailed to: **Commissioner of Patents and Trademarks**, P.O. Box 1450, Alexandria, VA 22313-1450 or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

/KIMBERLY EVANS/Examiner, Art Unit 3629

/Jamisue A. Plucinski/

Supervisory Patent Examiner, Art Unit 3629